

## REMARKS

Applicant respectfully requests reconsideration of this application as amended.

In the Office Action, claims 1-5, 7-17, 19-29, 31-41, and 43 were pending and rejected. A response was filed and an advisory action was issued. In the advisory action, the Examiner stated that the response did not put the present application in condition of allowance.

In this response, no claim has been canceled. Claims 1, 7-8, 11, 13, 19-20, 23, 25-26, 31-32, 35, 37-39, and 43 have been amended. New claims 44-52 have been added. No new matter has been added.

Claims 1-5, 7-10, 13-17, 19-22, 25-29, 31-34, and 38-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,524,193 of Covington (“Covington”) in view of U.S. Patent No. 5,337,362 of Gormish et al. (“Gormish”) and U.S. Patent No. 5,905,248 of Russell (“Russell”). Claims 11-12, 23-24, 35-36, and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Covington in view of Gormish, Russell, and U.S. Patent No. 5,880,740 of Halliday (“Halliday”).

It is respectfully submitted that the currently pending claims of the present application include limitations that are not disclosed or suggested by the cited references. Specifically, independent claim 1 as amended recites as follows:

1. A method comprising:  
creating a multimedia annotation for a paper document, the multimedia annotation representing at least one of an audio sound and a video clip; and  
creating a first multimedia document by combining the paper document and the multimedia annotation, such that the multimedia annotation can be extracted and decoded subsequently from the first multimedia document and played via a multimedia player, wherein the first multimedia document is generated as a part of reproducing the paper document via a document reproduction system.

(Emphasis added)

Independent claim 1 requires a multimedia annotation that includes at least one of an audio sound and a video clip and creating a multimedia document by combining a paper document with the multimedia annotation, such that the multimedia annotation can be extracted

and decoded from the multimedia document subsequently and played using a multimedia player, where the above operations are performed as a part of reproducing the paper document via a document reproduction system. The above limitations are absent from the cited references, individually or in combination.

Rather, Covington relates to a document editing software that provides a method for annotating an electronic document, rather than a paper document (see, Abstract and Summary of Covington). It is respectfully submitted that Covington fails to disclose or suggest the above limitations recited in claim 1. Although Covington discloses multimedia annotations, there is no suggestion of adding the multimedia annotations, particularly an audio sound or a video clip, with a paper document, where the multimedia annotation can be extracted, for example, by scanning and decoding the multimedia annotation from the paper document and played using a multimedia player.

Gormish relates to a method for placing digital data on a plain paper. The digital data of Gormish does not appear to be multimedia annotation, particularly, the multimedia annotation having at least one of an audio sound and a video clip. There is no mention or suggestion within Gormish that a multimedia annotation, such as, an audio sound or a video clip, can be added into a paper document. Thus, neither Covington nor Gormish, individually or in combination, discloses or suggests that the multimedia document having multimedia annotation, such as, for example, an audio sound or a video clip, etc., is generated as part of reproducing a paper document.

In addition, independent claim 1 includes a limitation that the multimedia document having the multimedia annotation is generated as a part of reproducing the paper document via a document reproduction system. This limitation is also absent from the cited references. The Examiner contends that Russell discloses such a limitation. Specifically, the Examiner stated:

“Russell does teach that a multimedia document is generated as part of reproducing the paper document via a document reproduction system in fig. 1, 1A, the abstract and col. 3 lines 50-54. Russell integrates embedded hyperlinks pointing to internet resources, which could be audio or video clips, into a paper document.”

(3/29/2004 Office Action, page 3, emphasis added)

Applicant respectfully disagrees. Although Russell disclosing scanning a barcode as a URL and accessing a Web page linked with the URL, such a disclosure does not read on a multimedia annotation having at least one of an audio sound or video clip and such a URL is not the same as an audio sound or video clip. Further, Russell only discloses scanning or reading a barcode from a paper document. Russell fails to disclose how to generate such a paper document. Specifically, Russell fails to disclose generating a multimedia paper document having at least one audio sound and video clip as a part of reproducing the paper document using a document reproduction system. It is respectfully submitted that one with ordinary skill in the art would not, based on the teachings of Russell, be able to arrive at the present invention as claimed because it lacks a reasonable expectation of success.

There is no suggestion in the cited references to combine Covington, Gormish, and Russell. Specifically, Covington relates to an editing application for the electronic documents, which cannot reasonably be applied to a paper document, while Gormish relates to processing a paper document. Covington and Gormish deal with significantly different problems and their approaches are significantly different. It is respectfully submitted that it lacks the motivation to combine Covington with Gormish.

Furthermore, even if, for the sake of the arguments, the cited references were combined, such a combination still lacks the limitations set forth above. For at least the reasons set forth above, Halliday also fails to disclose or suggest the above limitations. Therefore, it is respectfully submitted that independent claim 1 is patentable over the cited references.

Similarly, independent claims 13, 25, and 37 include limitations similar to those recited in claim 1. Thus, for at least the reasons similar to those discussed above, claims 13, 25, and 37 are patentable over the cited references. Given that the rest of the claims depend from one of the above independent claims, it is respectfully submitted that these claims are also patentable over the cited references.

Further, with respect to claims 8, 20, and 32, these claims include limitations that an image of the paper document is unconsciously captured during the reproduction of the paper document without user intervention and a second multimedia document is generated by combining the image of the paper document and the multimedia annotation. Thereafter, the image of the paper document and the multimedia annotation are stored in storage. These limitations are also absent from the cited references.

The Examiner contends that Russell discloses such limitations. Specifically, the Examiner stated:

“What Covington does not explicitly teach is generating an image of the paper document, the image of the paper document being unconsciously captured during the reproduction of the paper document without user intervention. Russell teaches reproducing a paper document from which an image also exists in fig. 1, 1A, the abstract and col. 3 lines 50-54. It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined Russell and Gormish into Covington to have created the claimed invention.”

(3/29/2004 Office Action, page 9, emphasis added)

Applicant respectfully disagrees. Russell discloses scanning a barcode from a paper document using a handheld scanner without mentioning generating an image of the paper document. There is no teaching or suggestion that an image of a paper document is generated unconsciously without user intervention during a reproduction of the paper document (e.g., while copying the paper document). Such a suggestion can only be found in Applicant's disclosure. It would be impermissible hindsight to use Applicant's own disclosure against the Applicant. Therefore, in addition to those as applied to their independent claims, independently, it is respectfully submitted that claims 8, 20, and 32 are patentable over the cited references.

Further, with respect to claims 11, 23, and 35, these claims include limitations that automatically emailing the electronic multimedia document to a recipient as a part of reproducing the paper document using the document reproduction system. It is respectfully submitted that these limitations are clearly absent from the cited references.

The Examiner contended that col. 8 lines 5-28 of Holliday. The section relied upon by the Examiner merely describes sending image through an email. However, Holliday fails to disclose or suggest automatically emailing the combined multimedia document as part of reproducing the paper document using a document reproduction system (e.g., while copying a paper document using a copy machine, where the copy machine has the capability of sending electronic mails). Therefore, in addition to those as applied to their independent claims, independently, it is respectfully submitted that claims 11, 23, and 35 are patentable over the cited references.

It is respectfully submitted that the cited references, individually or in combination, also fail to disclose or suggest the limitations set forth in the newly added claims 44-52.


In view of the foregoing, Applicant respectfully submits the present application is now in condition for allowance. If the Examiner believes a telephone conference would expedite or assist in the allowance of the present application, the Examiner is invited to call the undersigned attorney at (408) 720-8300.

Please charge Deposit Account No. 02-2666 for any shortage of fees in connection with this response.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN

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